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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,952	09/26/2003	Denny Jaeger	4337	7292
7590 10/29/2010				
Harris Zimmerman Law Offices of Harris Zimmerman Suite 710 1330 Broadway Oakland, CA 94612-2506				
EXAMINER				
BRIER, JEFFERY A				
ART UNIT		PAPER NUMBER		
2628				
MAIL DATE		DELIVERY MODE		
10/29/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/671,952

**Applicant(s)**

JAEGER, DENNY

**Examiner**

Jeffery A. Brier

**Art Unit**

2628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. The amendments filed on 09/24/2010 have been entered.
2. The supplemental reply filed on 09/28/2010 was not entered because supplemental replies are not entered as a matter of right except as provided in 37 CFR 1.111(a)(2)(ii). The supplemental reply is clearly not limited to placement of the application in condition for allowance because support for the claim amendments is not conveyed by applicant's specification. The claim amendments contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Each of the independent claims "one or more control devices" and "one or more chart components" which under one claim interpretation is claiming one control device and one chart component. Applicants specification only describes pie chart or bar chart for two or more graphic control devices and zero graphic control devices but not the newly claim one graphic control devices, refer to paragraphs 30, 68, 76, 93, and 94 and to the cited dictionary.com definitions of pie chart and bar chart. While applicants specification at paragraphs 31, 51, 106, and 111 describes a single fader this single fader is controlling multiple charts having multiple pie segments or bars. Applicants arguments filed on 09/28/2010 at page 17 of 18 asserts with regard to support for the newly claimed "one or more": "Applicant is entitled to this claim language, based on the thorough specification, and this claim language does not alter the allowability of the claims over the prior art." but does not

point to any specific location in the specification that supports applicants assertion. Therefore, applicants specification fails to convey applicants newly claimed one control device and one chart component. Thus, the 09/28/2010 supplemental reply is clearly not limited to placement of the application in condition for allowance and has not been entered. MPEP 714.03(a).

### ***Response to Arguments***

3. Applicant's arguments and claim amendments filed 09/24/2010 have been fully considered. While they overcome the issues set forth in the office action mailed on 06/28/2010 they introduce new issues set forth below.

### ***Claim Objections***

4. Claims 2, 5-9, 11-13, 15, 18-22, and 24-28 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The parent independent claims (claims 1, 10, 14, and 23) claim "In a computer apparatus ... a method for ... the method comprising" while their dependent claims only refer to "The method" or "The computer apparatus", thus, the dependent claims appear to claim only a method (claims 2, 5-9, 11-13, and 27) or to claim only a computer apparatus (claims 15, 18-22, 24-26, and 28). MPEP 608.01(n) II and III Original Eighth Edition, August 2001 Latest Revision July 2010.

608.01(n)Dependent Claims Original Eighth Edition, August 2001 Latest Revision

July 2010 states:

## II.TREATMENT OF IMPROPER DEPENDENT CLAIMS, at pages 600-90 to 600-91

The initial determination, for fee purposes, as to whether a claim is dependent must be made by persons other than examiners; it is necessary, at that time, to accept as dependent virtually every claim which refers to another claim, without determining whether there is actually a true dependent relationship. The initial acceptance of a claim as a dependent claim does not, however, preclude a subsequent holding by the examiner that a claim is not a proper dependent claim. Any claim which is in dependent form but which is so worded that it, in fact is not, as, for example, it does not include every limitation of the claim on which it depends, will be required to be *canceled* as not being a proper dependent claim; and cancelation of any further claim depending on such a dependent claim will be similarly required. Where a claim in dependent form is not considered to be a proper dependent claim under 37 CFR 1.75(c), the examiner should object to such claim under 37 CFR 1.75(c) and require cancellation of such improper dependent claim or rewriting of such improper dependent claim in independent form. See *Ex parte Porter*, 25 USPQ2d 1144, 1147 (Bd. of Pat. App. & Inter. 1992) (A claim determined to be an improper dependent claim should be treated as a formal matter, in that the claim should be objected to and applicant should be required to cancel the claim (or replace the improper dependent claim with an independent claim) rather than treated by a rejection of the claim under 35 U.S.C. 112, fourth paragraph.). The applicant may thereupon amend the claims to place them in proper dependent form, or may redraft them as independent claims, upon payment of any *necessary* additional fee.

Note, that although 37 CFR 1.75(c) requires the dependent claim to further limit a preceding claim, this rule does not apply to product-by-process claims.

## III.INFRINGEMENT TEST, at page 600-91

The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim.

### § 1.75 Claim(s) states:

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

(b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.

(c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim ("multiple dependent claim") shall refer

to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. For fee calculation purposes also, any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have paid therein the fee set forth in § 1.16(j). Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The independent claims claim "In a computer apparatus having a processor and a display" and "a method for creating and manipulating ... the method comprising", thus, the independent claims are unclear if the invention is a machine or a process. The dependent claims refer to either "The method" (claims 2, 5-9, 11-13, and 27) or "The computer apparatus" (claims 15, 18-22, 24-26, and 28). In view of MPEP 2173.05(p) Original Eighth Edition, August 2001 Latest Revision July 2010 at page 2100-230 claims 1-28 are indefinite.

## II.PRODUCT AND PROCESS IN THE SAME CLAIM at page 2100-230

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. *\*>IPXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005);< *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990) *\*>(< claim directed to an automatic transmission workstand and the method \* of using it \* held \*\*ambiguous and properly rejected under 35 U.S.C. 112, second paragraph>)<.*

Such claims *\*>may<* also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

### ***Claim Rejections - 35 USC § 101***

#### 7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter for the following two reasons.

a) The independent claims claim "In a computer apparatus having a processor and a display" and "a method for creating and manipulating ... the method comprising", thus, the independent claims are unclear if the invention is a machine or a process. The dependent claims refer to either "The method" (claims 2, 5-9, 11-13, and 27) or "The computer apparatus" (claims 15, 18-22, 24-26, and 28). In view of MPEP 2173.05(p) Original Eighth Edition, August 2001 Latest Revision July 2010 at page 2100-230 claims 1-28 are non-statutory.

b) Based upon consideration of all of the relevant factors with respect to the claim as a whole, claims 1, 3, 4, 10, 14, 16, 17, and 23 are held to claim an abstract

idea, and is therefore rejected as ineligible subject matter under 35 U.S.C. § 101. The rationale for this finding is explained below:

The apparatus defined in the preamble is not claimed to be the actor of the method steps. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The claimed method steps:

(1) are not tied to another statutory category (such as a particular apparatus) because the nominal recitation of displaying on display is considered insignificant extra-solution activity for the abstract idea steps;

(2) do not transform underlying subject matter (such as an article or material) to a different state or thing because the act of displaying on display does not transform an article or material; and

(3) are abstract because the mechanism by which the claim's abstract idea steps are implemented is subjective or imperceptible, see Federal Register Vol. 75, No. 142, Tuesday, July 27, 2010 at page 43927 second and third columns under heading of Factors Weighing Against Eligibility.

Dependent claims 2, 5-9, 11-13, 15, 18-22, 24-28 when analyzed as a whole are held to be ineligible subject matter and are rejected under 35 U.S.C. § 101 because the



additional recited limitation(s) fail(s) to establish that the claim is not directed to an abstract idea, as detailed below:

Claims 2 and 15 only change a numeric value and perform insignificant extra-solution activity of changing size of chart components on the display.

Claims 5 and 18 only claim programming graphic control devices with at least one of text and numeric value.

Claims 6 and 19 only claim perform insignificant extra-solution activity of displaying a chart on the display and defines the information displayed.

Claims 7 and 20 only further defined the information displayed.

Claims 8 and 21 only claim changing elements of information data and related element in graphic control devices and graphic chart.

Claims 9 and 22 only claim changing numeric value, size and information.

Claims 11 and 24 only claim changing size and information.

Claims 12 and 25 only claim perform insignificant extra-solution activity of displaying a charts on the display.

Claims 13 and 26 only claim changing an element of information data and related element in graphic control devices and graphic chart and second information.

Claims 27 and 28 abstractly claim drawing a second modifier arrow and the arrows characteristics.

Note the preamble of dependent claims 15, 18-22, 24-26, and 28 refer to computer apparatus but the body of these claims are method steps not tied to the computer apparatus as evidenced by their parent claims. A preamble is generally not

accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hira*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

### ***Double Patenting***

9. Applicant is advised that should claims 1-13 and 27 be found allowable, claims 14-26 and 28 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A. Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:30 to 4:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xiao Wu can be reached at (571) 272-7761. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffery A. Brier/  
Primary Examiner, Art Unit 2628

